

**Amendments to the Drawings:**

Figure 2 is amended to correctly depict relatively flat body by reference character

**22.**

Replacement Sheet:

Figure 2

## REMARKS

The Applicant has carefully reviewed and considered the Examiner's Action mailed July 13, 2005. Reconsideration is respectfully requested in view of the foregoing amendments and the comments set forth below.

Applicant thanks the Examiner Harris for the courtesies extended to his representative during the telephonic interview held on November 9, 2005. During that interview, independent claim 1 was discussed as interpreted in view of Figure 3 of the application, as were the applied references, specifically U.S. Patent No. 5,466,886 to Lengyel et al. U.S. Patent No. 4,899,506 to Chapman et al. Applicant's attorney explained that the claimed invention was directed to an electrical fitting (shown in Figure 3 - recited in claims 1-7) and a system including the fitting (claim 8). Unlike Lengyel or Chapman, Applicants' invention is a relatively flat body from which equally spaced legs project where the legs have a tip where, in use, the tips of each leg grips a form wall in order to provide a sturdy and solid base that holds the electrical box mounted flush with an opposing form wall and the conduit during the pouring of concrete. It is this simple structure that achieves the results described in paragraphs [006] through [012] of the originally-filed specification.

Examiner Harris recognized that the structure of the Applicant's described invention was different from that of the prior art, but indicated that the Patent Office broadly interprets recitations in the claims. The figures of the originally-filed application show a centrally located opening **9** in a relatively flat body **22** and a plurality of equally spaced legs **24** where the relatively flat body is thinner than the length of each leg. Each leg **24** had a tip, which is smaller than the legs and thereby provides a nicer finish to the

resultant concrete walls as only the small tips of the electrical fitting will be revealed when the forms are removed. Accordingly, the Examiner suggested that independent claims 1 and 8 be amended to include these structural features. The Examiner stated that the prior art of record, including U.S. Patent No. 5,420,376 to Rajecki do not disclose these features and do not render the same obvious.

By this Amendment, claims 1 and 8 are amended to recite the above discussed features that distinguish the claimed invention from the applied prior art, and Figure 2 of the drawings is replaced as discussed above. Accordingly, claims 1-16 are pending in the present application.

Claims 1-8 and 10-16 were rejected under 35 U.S.C. §103 (a) as being unpatentable over U.S. Patent No. 5,466,886 to Lengyel et al. (hereinafter referred to as “Lengyel”) in view of U.S. Patent No. 4,899,506 to Chapman et al. (hereinafter referred to as “Chapman”) as explained in paragraph 3 spanning pages 2-5 of the Action. In view of the foregoing rejections, it is believed that this rejection is moot. However, this rejection is respectfully traversed.

As explained during the telephonic interview, the claimed invention is directed to an electrical fitting for installation of electrical systems in poured concrete and a system for the installation of electrical boxes in poured concrete where the claimed **fitting** holds an electrical box flush during the pouring of concrete. This is achieved by an electrical fitting for installation of electrical systems in poured concrete, which includes 1) a relatively flat body of material having a centrally located opening for receiving an electrical conduit; 2) a number of equally spaced legs projecting from a rear side of the relatively flat body wherein the relatively flat body is thinner than a length of each leg

and the thickness of the relatively flat body is taken in the same direction as the legs project; and 3) a tip centrally disposed on a top of each leg and having a smaller diameter than that of each leg wherein 4), in use, the tip grips the form wall and provides a sturdy and solid base that holds the electrical box and the conduit in position during the pouring of concrete and 5) wherein the length of each spaced leg is designed to allow concrete to flow between the body and the form wall.

As the Action acknowledges, Lengyel does not disclose “a relatively flat body”. Contrary to the Action’s position, the mounting flanges are not the recited legs that project from a rear side of the body and are longer than the thickness of the relatively flat body, as set forth in independent claims 1 and 8. In that the mounting flanges and body of Lengyel rest on a floor, it is unclear why the Action asserts that Figure 7 of Lengyel shows the recited tips which, in use, grip a form wall and allow concrete to flow between the body and the form wall. Figure 7 illustrates a flange with a flat surface that contacts the floor. Mounting flanges 40 of Lengyel are used solely for mounting fasteners, such as screws or nails to a subfloor or substructure. Lengyel does not disclose a tip when, in use, grips a form wall and provides a sturdy and solid base. Thus, it is submitted that Lengyel does not disclose, teach or suggest the recited tips.

The secondary reference to Chapman, like Lengyel, is directed to fitting used in floor construction. Thus, the problem solved by Applicant’s invention is not addressed by these references and it is respectfully submitted that there is no reason to modify a floor installation fitting to overcome problems associated with fittings in the pouring of concrete to form walls. As explained in the telephonic interview, concrete is poured from above and surrounds devices taught by Lengyel and Chapman so that the floor on which

the device is mounted is covered with concrete. There are no form walls to remove. In applicant's invention, the fitting holds an electrical installation between two opposing form walls, and concrete is poured from above the installation between the two opposing form walls. After the concrete is set, the form walls are removed and the electrical installation is within the concrete wall and the equally spaced legs with small diameter tips enable the concrete to completely surround the electrical fitting so that only the small diameter tips show when the forms are removed.

Chapman, like Lengyel, does not disclose, teach or suggest a relatively flat body wherein the relatively flat body is thinner than a length of each leg, when the thickness of the relatively flat body is taken in the same direction as the legs project. Thus, while the service fitting **50** of Chapman is not as deep as the housing **12** of Lengyel, Chapman does not teach or suggest that service fitting **50** could be thinner than the electrical box **52** and is silent about the thickness of the service fitting **50** in relation to the length of its adjusting legs **18**, **70**, and **72**. To the contrary, Chapman states that the depth of the concrete floor **71** is substantially equal to the box depth **69** (Column 3, lines 59-61), which suggest that the box depth is going to be thicker than the length of the adjusting legs.

Further, Chapman does not disclose a service fitting with a centrally located opening or hole. Instead, Chapman discloses a fitting with a bottom **22**. The centrally located opening provides the electrical fitting of the claimed invention with a stronger base as its position aides in the gripping function (frictionally engaged) of the tips. Accordingly, it is respectfully submitted that one of ordinary skill in the art would not have been motivated to modify Lengyel so that its housing **12** is thinner than mounting

flanges 40 in view of Chapman as Chapman teaches a fitting with a solid bottom and having a depth that is substantially equal to that of the poured concrete floor. It is submitted that one of ordinary skill in the construction art would not have considered a concrete floor than is thinner than the length of mounting flanges 40 as such a concrete floor would be too thin to be a safe and reasonable structure.

The adjusting screws of Chapman, unlike the equally spaced legs of Applicant's invention, have a tip or base that has a **greater** diameter than the adjusting screw. Chapman discloses the purpose of the adjusting screws is to adjust the service fitting 50 so that it is flush with the top of the poured concrete. The adjusting screws enable the fitting to be placed on an uneven floor and the service fitting can be adjusted so that it is flush with the top of the poured concrete. Thus, neither Chapman nor Lengyel discloses the purpose of the or structure of the recited tip. Accordingly, there is no motivation to modify Lengyel or Chapman to have a base or tip that has a smaller diameter than that of its leg. Without the necessary motivation, one of ordinary skill in the art would not have found it obvious to combine teachings from Lengyel or Chapman to achieve the claimed invention.

In *In re Mills*, 16 USPQ2d 1430 (1990), the Federal Circuit held that the Board of Patent Appeals and Interferences erred by requiring the Applicant to show that the prior art reference lacked functional characteristics of the claimed device because the claims were rejected on the basis of obviousness and the prior art reference does not describe or suggest the claimed invention's structure. That is, the Federal Circuit held that the recited functional language of the claim needs to be described and/or suggested by the prior art reference in order to make a proper obviousness rejection. The Action cannot ignore the

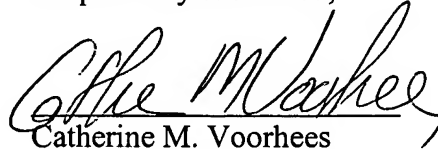
functional language recited in the claims. The functional language adds structure to the claimed invention that needs to be described and/or suggested in order to make a proper obviousness rejection. As argued above, neither Lengyel nor Chapman disclose features 1) - 5) of the claimed invention.

In view of the above, it is submitted that one of ordinary skill in the art would not have been motivated to combine the cited prior art to achieve Applicant's invention as none of the prior art references teaches the installation of electrical systems in walls formed by poured concrete. It is only Applicant's own disclosure that recognizes that the simple structure of a relatively flat fitting with a centrally located opening, equally spaced legs that are longer than the relatively flat body is thin and tips of each leg having a smaller diameter than each leg can effectively support an electrical box while concrete is poured through the legs. Thus, it is respectfully submitted that the Action relies on impermissible hindsight to modify the base reference as the cited references teach away from the claimed invention. Reconsideration and allowance of claims 1-16 of the present application are respectfully requested.

If the Examiner believes that a conference would help to advance the prosecution of the present application, she is requested to telephone the undersigned at the number below.

Date: November 10, 2005

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Catherine M. Voorhees", written over a horizontal line.

Catherine M. Voorhees

Registration No. 33,074

VENABLE LLP

P.O. Box 34385

Washington, D.C. 20043-9998

Telephone: (202) 344-4000

Telefax: (202) 344-8300

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